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APPLICATION NO. 88/028,432	FILING DATE 03/28/97	FIRST NAMED INVENTOR HUGHES	ATTORNEY DOCKET NO. 81882-P872
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EXAMINER HSH, A
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ART UNIT 2738	PAPER NUMBER
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DATE MAILED: 02/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

08/825,492

Applicant

HUGHES ET AL

Examiner

Alpus H. Hsu

Group Art Unit

2738



☒ Responsive to communication(s) filed on Dec 14, 1999

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-3, 5-8, 14-16, 18-22, and 24-26 is/are pending in the applicat

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-3, 5-8, 14-16, 18-22, and 24-26 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on May 7, 1999 is ☒ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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1. The request filed on Dec. 14, 1999 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/825,492 is acceptable and a CPA has been established. An action on the CPA follows.

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 21, 22 and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 21, 22 and 26 are directed to a data format which does not belong to any statutory subject matter as indicated above.

4. Claims 1-3, 5-8, 14-16, 18-22, 24-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claimed feature of ATM cell having a header that includes **information indicative of a merging method used** as in claims 1, 14 and 21 is not disclosed in any part of the specification.

5. Claims 1, 14 and 21 recite the limitation of "the merging method used" in each claim. There is insufficient antecedent basis for this limitation in the claim.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1-3, 5-8, 14-16, 18-20, 24 and 25 are rejected under 35 U.S.C. 102(a) as being anticipated by Takashima et al. (of record).

By broadly interpreting the ATM cells (cells #1, #2, ... etc.) as the claimed partially filled ATM cells, and the new ATM cell (10) as the claimed merged ATM cell, Takashima et al. discloses a method and apparatus for merging partially filled ATM cells in ATM communications network (col. 10, lines 10-53, col. 12, lines 18-55, col. 14, line 30 to col. 15, line 26, and Figs. 15, 18-20, 28-31) as in claims 1-3, 5-8, 14-16, 18-20.

8. Applicant's arguments filed Dec. 14, 1999 have been fully considered but they are not persuasive.

In the remark, regarding 101 rejection, the applicant argues that an ATM cell is a combination of information descriptions or representations organized to carry useful information between ATM devices, and an ATM cell is a specific arrangement of information elements, which are unique sequences of bits that exist within computer systems, with each bit sequence specifically identifying and representing an address, control information or user data information, which are real, tangible things that qualify as patentable subject matter. The examiner disagrees since in claims 21, 22 and 26, only a data format showing the contents of payload and header in an ATM cell is recited in the claim, which does not fall into any category of the statutory subject matter.

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Regarding 112, 1st paragraph, the applicant argues that the claimed feature of ATM cell having a header that includes **information indicative of a merging method used** as in claims 1, 14 and 21 are supported by the specification by referring to page 8, line 26 to page 9, line 4 of the specification. The examiner disagrees since on page 8, line 26 to page 9, line 4 of the specification, it merely describes that the VCI of the merged cell could be used to indicate the number of cells merged, which is different from the claimed feature of ATM cell having a header that includes **information indicative of a merging method used**.

Regarding 102 rejection, the applicant argues that Takashima reference fails to teach or suggest the claim limitation of “including information indicative of a merging method used in the header of the new ATM cell”. However, in view of the specification, the so-called “information indicative of a merging method used” is merely a value or a number in VCI indicating the number of cells merged, wherein Takashima reference clearly provides the same teaching as claimed in col. 12, lines 18-55.

In view of the above reasoning, the rejections regarding 101, 112 1st paragraph and 102(a) have been sustained.

9. This is a CPA of applicant's earlier Application No. 08/825,492. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in

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this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. **Any response to this final action should be mailed to:**

**Box AF**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 305-9051, (for formal communications; please mark "EXPEDITED  
PROCEDURE")

**Or:**

(703) 305-3988 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

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Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

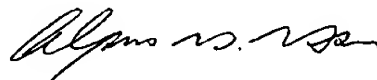
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alpus H. Hsu whose telephone number is (703) 305-4377. The examiner can normally be reached on Monday through Friday from 6:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou, can be reached on (703) 305-4744.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Alpus H. Hsu      /AHH

February 24, 2000



**ALPUS H. HSU  
PRIMARY EXAMINER**